



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/108,673 07/01/98 TENG

C ISIS-3105

HM12/0822

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EXAMINER

SANDAI S. W	
ART UNIT	PAPER NUMBER

1636

DATE MAILED:

08/22/01

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 09/108,673	Applicant(s) Teng et al	
	Examiner WILLIAM SANDALS	Art Unit 1636	<i>[Signature]</i>
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
<p>THE REPLY FILED <u>Aug 14, 2001</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.</p>			
THE PERIOD FOR REPLY [check only a) or b)]			
<p>a) <input type="checkbox"/> The period for reply expires _____ months from the mailing date of the final rejection.</p> <p>b) <input checked="" type="checkbox"/> In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.</p>			
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<p>1. <input type="checkbox"/> A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.</p> <p>2. <input type="checkbox"/> The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.</p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) will not be entered because:</p> <p>(a) <input checked="" type="checkbox"/> they raise new issues that would require further consideration and/or search. (See NOTE below);</p> <p>(b) <input type="checkbox"/> they raise the issue of new matter. (See NOTE below);</p> <p>(c) <input type="checkbox"/> they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> they present additional claims without cancelling a corresponding number of finally rejected claims.</p>			
<p>NOTE: <u><i>the amendment as filed requires new grounds of rejection due to new limitations in claim 25.</i></u></p> <hr/>			
<p>4. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____ _____</p>			
<p>5. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).</p>			
<p>6. <input checked="" type="checkbox"/> The a) <input type="checkbox"/> affidavit, b) <input type="checkbox"/> exhibit, or c) <input checked="" type="checkbox"/> request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u><i>the amendment filed on August 14, 2001 raises new issues requiring a new ground for rejection. The claims continue to be rejected for reasons of record, due to the non-entry of the amendment. See attached.</i></u></p>			
<p>7. <input type="checkbox"/> The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.</p>			
<p>8. <input checked="" type="checkbox"/> For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any): Claim(s) allowed: _____ Claim(s) objected to: _____ Claim(s) rejected: <u><i>25-27, 40, 44-50, 53-64, and 66-81</i></u></p>			
<p>9. <input type="checkbox"/> The proposed drawing correction filed on _____ a) <input type="checkbox"/> has b) <input type="checkbox"/> has not been approved by the Examiner.</p>			
<p>10. <input type="checkbox"/> Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p>			
<p>11. <input checked="" type="checkbox"/> Other:<u><i>the amendment filed on August 14, 2001 was not signed. The advisory action responds to the after-final amendment as if it had been signed.</i></u></p>			

Rita Egy
D# 32



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DEA/FCE-1994

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EXAMINER	
W. Sandals	
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Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

Arguments presented in Paper No. 30, filed August 14, 2001 assert that the declaration of Dr. Teng provides a basis for enablement. As set forth in the rejection, while the delivery of nucleic acids across the lining of the intestine has been shown, the only intended use of such a delivery is to perform gene therapy, and this intended use is not enabled.

Amendments to the claims to cure the 35 USC 112, second paragraph deficiencies have been made in Paper No. 30 which would cure the deficiencies, however, the Paper has not been entered for reasons set forth in the advisory action. Therefore the amendments will not be entered, and the rejection stands for reasons of record.

Art Unit: 1636

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Sandals whose telephone number is (703) 305-1982. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

August 21, 2001

Terry A. McKelvey
TERRY MCKELVEY
PRIMARY EXAMINER